

The rejection is improper because Kinser does not disclose each and every element of the claims at issue. A claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. MPEP § 2131 (citing *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987)). Claim 1 claims a method for proactively maintaining a telephone system local loop that includes, “automatically predicting proactive maintenance,” in combination with other elements. Claim 13 claims a method for proactively maintaining a telephone system local loop that includes, “automatically predicting proactive maintenance,” in combination with other elements. Claim 18 claims a computer-readable medium on which is encoded computer program code for proactively maintaining a telephone system that includes, “computer program code for predicting proactive maintenance,” in combination with other elements.

Kinser does not disclose a method that includes “automatically predicting proactive maintenance,” in addition to the other elements of the claims. Further, Kinser does not disclose a computer-readable medium that includes “computer program code for predicting proactive maintenance,” in addition to the other elements of the claims. The Office asserts that claims 1, 13, and 18 read on Kinser “without taking into account the previous process which can be a *manual process*. Furthermore, according to Kinser, the *intent* of his invention is to *reduce manual intervention . . .*” (September 24, 2002 Office Action Summary, at p. 2) (emphasis added). Because Kinser teaches a manual process – even though the amount of manual intervention may be reduced – the Office clearly acknowledges that Kinser’s process cannot automatically predict proactive maintenance. Moreover, the Office readily admits that Kinser uses a computer to “*reduce the amount of manual activity required to analyze many sources of data . . .*” (Office Action Summary, at p. 7) (emphasis added). A process that reduces the amount of manual activity required to analyze data is not an automatic process that predicts proactive maintenance. Thus, Kinser does not anticipate independent claims 1, 13, and 18.

Therefore, Applicants respectfully submit that independent claims 1, 13, and 18 are each patentable over Kinser. As claims 2-3, 5-9, 11, and 12 depend ultimately from claim 1 and claims 14-16 depend ultimately from claim 13, Applicants respectfully submit that these claims are each patentable over Kinser. Accordingly, Applicants respectfully request that the rejections to claims 1-3, 5-9, 11-16, and 18 be withdrawn, and the claims allowed.

B. Claims 4, 17, 19, and 20

The Office has rejected claims 4, 17, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Kinser in view of Kulatunge. Claim 17 is independent. Claim 4 depends from claim 1. Claims 19 and 20 depend from independent claim 18. The Office's rejection of claims 4, 17, 19, and 20 is respectfully traversed.

The rejection is improper because there is no suggestion or motivation to combine the references to result in Applicants' invention. One of the criteria for a *prima facie* case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP § 2143. The Office Action asserts that, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kulatunge into that of Kinser thus making it possible to predict future possible errors and taken corrective measures." This general assertion is not a showing of the necessary suggestion or motivation to *modify Kinser or to combine Kinser and Kulatunge*.

"The teaching or suggestion to make the claimed combination *and the reasonable expectation of success* must be found in the prior art, not in applicant's own disclosure." MPEP § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d (Fed. Cir. 1991) (emphasis added)). No teaching or suggestion to combine Kinser and Kulatunge, nor any grounds for a reasonable expectation of success in combination, has been shown. Thus, the Office has not established a *prima facie* case of obviousness.

Therefore, independent claim 17 is patentable over Kinser in view of Kulatunge. Accordingly, the rejection to claim 17 should be withdrawn and the claim allowed.

Independent claims 1 and 18 have not been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinser in view of Kulatunge. Further, as discussed above independent claims 1 and 18 are patentable. Irrespective of the additional grounds of rejection cited against dependent claims 4, 19, and 20, these claims are allowable since they each depend upon an allowable independent base claim. Accordingly, Applicants respectfully request that the rejections to claims 4, 19, and 20 be withdrawn and the claims allowed.

C. Claims 1, 13, and 18

The Office has rejected claims 1, 13, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Kulatunge. The Office's rejection of claims 1, 13, and 18 is respectfully traversed.

The rejection is improper because there is no suggestion or motivation to modify Kulatunge to result in Applicants' invention. As discussed above, one of the criteria for a *prima facie* case of obviousness is that there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. MPEP § 2143. The Office Action states that Kulatunge fails to teach a digital loop carrier. The Office then asserts that "[d]igital loop carriers are notoriously well known in the art and given the fact that *Kulatunge fails to put a restriction on the network type*, it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Kulatunge into *any* network type thus making it possible to foresee future faults/errors and to take precautions accordingly." (Office Action Summary at p. 6) (emphasis added). Applicant respectfully traverses this assertion. Such a general, unsupported assertion is not a showing of the necessary suggestion or motivation to *modify Kulatunge*.

As described above, the teaching or suggestion to make the claimed combination *and the reasonable expectation of success* must be found in the prior art, not in Applicants' own disclosure. No teaching or suggestion to modify Kulatunge, nor any grounds for a reasonable expectation of success in the modification, has been shown. Contrary to the Office's assertion, it does not follow that because Kulatunge fails to put a restriction on the network type that it is obvious to incorporate Kulatunge into *any* network type. Kulatunge shows no recognition of, or pertinence to, predicting proactive maintenance of a telephone system local loop by including a digital loop carrier. Thus, the Office has not established a *prima facie* case of obviousness.

Therefore, independent claims 1, 13, and 18 are patentable over Kulatunge. Accordingly, the rejections to claims 1, 13, and 18 should be withdrawn, and the claims allowed.

D. Claim 10

The Office has rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Kinser. Claim 10 depends from claim 1. As discussed above, claim 1 is patentable over Kinser. Irrespective of the additional grounds of rejection cited against dependent claim 1, this claim is allowable since it depends upon an allowable independent base claim. Accordingly, Applicants respectfully request that the rejection to claim 10 be withdrawn, and the claim allowed.

CONCLUSION

For the reasons stated herein, the undersigned respectfully submits that claims 1-20 are allowable and respectfully requests the Examiner to allow all claims. A favorable Office Action is respectfully solicited. The Examiner is invited to contact the undersigned to discuss any matter related to the application.

Respectfully submitted,

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